INDEX

	Page
Opinion below	1
Jurisdiction	1
Question presented	1
Statutes and rules involved	2
Statement	4
1. The administrative determination	4
2. The district court's determination	8
Argument	9
Conclusion	12

CITATIONS

Cases:

Evans v. *Watson*, 269 F. 2d 775, certiorari denied, 361 U.S. 900	11
Kingsland v. *Dorsey*, 338 U.S. 318	10
United States v. *Tucker Truck Lines*, 344 U.S. 33	11

Statutes and rules:

35 U.S.C. 31	2, 10
35 U.S.C. 32	2, 8
Patent Office Rules of Practice in Patent Cases, 37 C.F.R. 1.1 *et seq.*:	
Rule 344	3
Rule 345	3, 4, 5, 10, 11
Rule 348	3, 6

In the Supreme Court of the United States

OCTOBER TERM, 1961

No. 682

GEORGE SPECTOR, PETITIONER

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The *per curiam* opinion of the United States Court of Appeals for the District of Columbia Circuit (Pet. App. 1a-2a) is reported at 296 F. 2d 420. The unreported order of the District Court for the District of Columbia appears in the Joint Appendix, p. 68.

JURISDICTION

The judgment of the court of appeals was entered on October 26, 1961. The petition for a writ of certiorari was filed on January 22, 1962. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether, in light of the evidence of record, the court of appeals and the district court correctly re-

fused to set aside an order of the Commissioner of Patents excluding petitioner from practice before the Patent Office for violation of the Patent Office Rule forbidding advertising by patent agents.

STATUTES AND RULES INVOLVED

1. 35 U.S.C, 31 and 32 provide:

> § 31. Regulations for Agents and Attorneys.
>
> The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.
>
> § 32. Suspension or Exclusion From Practice.
>
> The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having

immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

2. Rules 344, 345 and 348 of the Patent Office Rules of Practice in Patent Cases, 37 C.F.R. 1.344, 1.345 and 1.348, provide in pertinent part:

1.344 Professional Conduct.

Attorneys and agents appearing before the Patent Office must conform to the standards of ethical and professional conduct generally applicable to attorneys before the courts of the United States.

1.345 Advertising.

(a) The use of advertising, circulars, letters, cards, and similar material to solicit patent business, directly or indirectly, is forbidden as unprofessional conduct, and any person engaging in such solicitation, or associated with or employed by others who so solicit, shall be refused recognition to practice before the Patent Office or may be suspended, excluded or disbarred from further practice.

(b) The use of simple professional letterheads, calling cards, or office signs, simple announcements necessitated by opening an office, change of association, or change of address, distributed to clients and friends, and insertion of listings in common form (not display) in a classified telephone or city directory, and

listings and professional cards with biographical data in standard professional directories shall not be considered a violation of this rule.

(c) No agent shall, in any material specified in paragraph (b) of this section, or in papers filed in the Patent Office, represent himself to be an attorney, solicitor or lawyer.

§ 1.348 Suspension or disbarment proceedings.

Except as otherwise provided, proceedings for suspension, disbarment, or exclusion from practice are before a Commissioner.

STATEMENT

Petitioner seeks review of an order of the Commissioner of Patents excluding him from practice as a registered agent before the Patent Office for a period of one year for his violation of Rule 345 of the Patent Office Rules of Practice in Patent Cases (37 C.F.R. 1.345, *supra*, p. 3), which prohibits the use of advertising to solicit patent business by a registered attorney or agent (J.A. 57).

The exclusion has not yet been put into effect. The petitioner obtained orders from both the district court and the court of appeals staying the exclusion while this action was pending before each of those courts. A further stay pending the filing of a petition for certiorari was refused by the court of appeals, because of petitioner's failure to comply with terms of the previous order that had conditioned the earlier stay on his discontinuance of advertising. Application for a stay was thereupon made to this Court. The Patent Office has agreed to stay the exclusion until seven days after this Court acts on the petition for certiorari.

THE ADMINISTRATIVE DETERMINATION

The Solicitor of the Patent Office, on November 16, 1959, preferred the following charge against petitioner (J.A. 2):

> That, in violation of Rule 345 of The Rules of Practice of the United States Patent Office in Patent cases, you caused to be published an advertisement to solicit patent business for you appearing on page 63 in the November, 1959 issue of Popular Mechanics, a photocopy of that page with the advertisement encircled being marked Exhibit A and being attached hereto and made a part hereof.

The advertisement therein referred to read as follows (J.A. 3):

> INVENTIONS, Ideas, patents wanted! By manufacturer. Cash, royalties. Sales promotions, invention development. George Spector, licensed professional engineer. 2615 Woolworth Building, New York.

On February 4, 1960, the Solicitor charged an additional violation of the rule, asserting (J.A. 6):

> That, in violation of Rule 345 of the Rules of Practice of the United States Patent Office in Patent cases, you caused to be published advertisements appearing on page 242 of the January 1960 issue of Popular Science Monthly and on page 1243 of the Manhattan Yellow Pages 1960, photocopies of such pages being marked, respectively, Exhibits E and F, and attached hereto and made a part hereof.

Exhibit E, referred to in the above charge, included the following advertisements, appearing both

under the heading, "For Inventors," and under the heading, "Inventions Wanted" (J.A. 11):

> INVENTORS' Complete Service. Cash–Royalties Sales. Inventions Researched. Patent Development Engineering. Free Invention Certificate. George Spector. Licensed Invention Engineer. 3615 Woolworth Building; New York.

The advertisement introduced as Exhibit F was an offer by George Spector, "Licensed Professional Engineer," of "INVENTORS' COMPLETE SERVICE," including the statement: "INVENTIONS AND IDEAS RESEARCHED AND FULLY PROTECTED" (J.A. 12).

A hearing was held on May 10, 1960, before the First Assistant Commissioner of Patents in compliance with Rule 348 of the Rules of Practice of the Patent Office, to consider the charges preferred by the Solicitor (J.A. 15). Petitioner contended that he placed the advertisements in his capacity as a Professional Engineer, and not as a Patent Agent (J.A. 33–35). To refute this assertion, the Solicitor offered into evidence, in addition to the exhibits already referred to, several pieces of correspondence allegedly mailed by petitioner to clients while acting as a Professional Engineer, one of which offered to "provide all or any of the services that an inventor requires in protecting and promoting his invention" (J.A. 7). In another, petitioner stated, "I therefore recommend that you let me proceed with the patent development required for the filing of a U.S. Patent Application" (J.A. 10). Petitioner testified

that in his business as Professional Engineer he performed a number of functions with respect to applications for patents, such as the drafting of claims and conducting patent searches, and on cross-examination he conceded that he had prepared a number of patent applications in response to the advertisements shown in the exhibits or to similar advertisements (J.A. 30, 34–35).

On the basis of the foregoing, as well as of additional evidence adduced at the hearing, the First Assistant Commissioner of Patents on June 30, 1960, issued an opinion in which he concluded (J.A. 54) that:

> Examination of the advertisements in Exhibits A, E and F makes it clear that these advertisements offer services in connection with the patenting of inventions. In particular, the reference to "INVENTOR'S Complete Service" and "Inventions Researched. Patent Development Engineering" in Exhibit E and to "INVENTORS' COMPLETE SERVICE," and "INVENTIONS and IDEAS RESEARCHED and FULLY PROTECTED" in Exhibit F indicate that the service offered involves protecting unpatented inventions by aiding in obtaining patents. Moreover, the evidence, including the concessions of respondent, establish that respondent has actually performed acts constituting "patent business," including conducting preliminary searches, giving advice as to filing patent applications, and preparing drawings, specifications and claims of patent applications, as a result of the advertising.

He therefore decided that petitioner should "be suspended from practice before the Patent Office for a period of one year"; however, he temporarily withheld issuance of an order so that petitioner could make arrangements for the prosecution of applications for which he was then responsible (J.A. 56). On August 10, 1960, the First Assistant Commissioner's order was issued, excluding petitioner "from practice as a patent agent in any application before the United States Patent Office, without prejudice to his registration after one year and after full compliance with the requirements of Rule 341, as in the case of one seeking registration who had not previously been registered" (J.A. 57).

2. THE DISTRICT COURT'S DETERMINATION

Pursuant to 35 U.S.C. 32, the petitioner sought review of this exclusion order in the district court (J.A. 58). After reviewing the evidence, the district court fully sustained the order of exclusion, finding, *inter alia* (J.A. 65–66):

> 8. The advertisements in Exhibits A, E, and F offer, on their faces, services in connection with the patenting of inventions.
>
> 9. The advertisements in Exhibits A, E, and F offer, on their faces, services which are usually performed by patent attorneys and patent agents for their clients.
>
> * * * * * *
>
> 11. By his own admissions and as shown by Exhibits B, C, D, G, H, I, K, and L, petitioner has offered to perform and has performed for those responding to his advertisements, such

> as those in Exhibits A, E, and F, services in connection with the patenting of inventions usually performed by patent attorneys and patent agents for their clients.

The district court concluded that "[t]he making of preliminary searches and the preparation of applications for patent constitute 'patent business' as that term is used in the said Rule 345"; and that the order of the First Assistant Commissioner of Patents was supported by "reliable, probative, and substantial evidence" and should be sustained (J.A. 66, 67).

On appeal, the United States Court of Appeals for the District of Columbia Circuit unanimously affirmed *per curiam* (Pet. 1a-2a).

ARGUMENT

The basic question presented by this case is a narrow and factual one. Moreover, the concurrent decisions of both courts below are clearly correct. Further review, we submit, is not warranted.

1. The main issue here is one of fact, *i.e.*, whether petitioner's advertisements constituted the solicitation of patent business. After a full hearing, the Commissioner of Patents concluded that they did. The correctness of this factual determination, by the administrator charged with the implementation of the statute, has already been affirmed by both courts below. Under the applicable Patent Office rule, the validity of which has already been fully established (see p. 11, *infra*), it follows that petitioner was properly excluded from practice. No additional review of that exclusion is called for here.

2. Moreover, the record conclusively demonstrated that petitioner was engaging in conduct properly prohibited by the rules of the Patent Office. Petitioner's advertisements emphasized the completeness of the service he offered for the protection of inventors. His responses to individuals who wrote him elaborated upon this promise and specifically offered to undertake the initial steps in obtaining a patent. The evidence clearly established that petitioner in fact performed work that is ordinarily performed by patent attorneys and agents, and he himself conceded that he had prepared patent applications in response to the advertisements in question. The record could scarcely be clearer to the effect that petitioner was soliciting patent business in violation of Patent Office rules.

The applicable statute expressly gives the Commissioner authority to "prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office * * *." 35 U.S.C. 31. Practice before the Patent Office is professional in nature and requires conduct consistent with high professional standards, which Congress has made the Commissioner of Patents primarily responsible for enforcing. *Kingsland* v. *Dorsey*, 338 U.S. 318. The Commissioner's Rule 345 provides essentially that each practitioner before the Patent Office shall be held to the same standard of professional conduct in regard to advertising as that required of lawyers, dentists, physicians, public accountants and architects, and there can be no real doubt here that petitioner's con-

duct fell short of the standards established by that rule.

It is no answer to suggest that the application of Rule 345 must be limited to advertisements specifically offering services in connection with "the prosecution of Patent applications before" the Patent Office (Pet. 7). So to restrict Rule 345 would render it so susceptible of evasion as to undermine its whole purpose. In any event, the particular services offered by petitioner, as described more fully above, are so closely identified with the prosecution of patent applications that they plainly fall within even the narrow definition of Rule 345 urged by petitioner.

3. Petitioner now seeks to raise for the first time the contention that Rule 345 is governed by vague and insufficient standards (Pet. 12–13). Since this point was raised neither before the administrator, the district court, nor the court of appeals, it would not seem to be open at this late date. *United States* v. *Tucker Truck Lines*, 344 U.S. 33, 37. Moreover, the contention is wholly without merit. There can be no serious challenge to the validity of the regulation. Less than three years ago, in *Evans* v. *Watson*, the validity of Rule 345 was fully sustained by the Court of Appeals for the District of Columbia Circuit, 269 F. 2d 775, and this Court denied certiorari, 361 U.S. 900.[2]

---

[2] Petitioner's contention (Pet. 15) that the First Assistant Commissioner's final order (dated August 10, 1960) was "not in conformity" with his decision and opinion (dated June 30, 1960) is entirely unfounded. In his decision, the First Assistant Commissioner announced that he would subsequently

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ARCHIBALD COX,
Solicitor General.

WILLIAM H. ORRICK,
Assistant Attorney General.

MORTON HOLLANDER,
EDWARD BERLIN,
Attorneys.

FEBRUARY 1962.

---

issue an order suspending petitioner from practice before the Patent Office for a year (J.A. 56). When issued, that order, which "excluded" petitioner "from practice * * * without prejudice to his registration [as a patent agent] after one year" (J.A. 57), was clearly within the scope of the First Assistant Commissioner's decision. Petitioner has pointed to no substantive difference between suspension from practice for a year and exclusion from practice for a year, nor is there any. Surely the fact that petitioner's return to practice was here conditioned on his complying with the requirements for a *de novo* application for registration is not such a difference, for relief from suspension could certainly be similarly conditioned. It should further be noted that petitioner did not raise this contention before the Commissioner of Patents nor in either of the courts below.